

REMARKS

Reconsideration of the present application is earnestly solicited. The application includes 4 claims, each of which is rejected in view of either Adamchick alone or Adamchick combined with another references. The Adamchick patent no. 5,761,668 was cited as a §102(e) reference. Applicant has submitted three Declarations (dated June 13, 2000, November 24, 2000, and January 27, 2001) under 37 C.F.R. § 1.131 antedating this primary reference. The declaration of June 13 was not considered due to the perceived omission of a showing that the invention was developed for use in a computer. The second declaration of November 24 was rejected as failing to establish diligence. Mr. Stout's latest Declaration included facts establishing such diligence. In spite of the many dated entries detailing Mr. Stout's efforts, this declaration was also dismissed on two grounds.

In the first ground, it was contended that Mr. Stout's efforts to contact several companies were an offer for use or sale, and not a reduction to practice. It appears that the Examiner has created a new presumption that an inventor's contact with companies, organizations and government agencies somehow becomes an offer for use or sale. A second implication is that offering an invention for use (as opposed to sale) is somehow improper and therefor discounted for purposes of establishing diligent effort to reducing the invention to practice. This presumption is clearly improper and without legal support. Moreover, this presumed ground for refusing Applicant's several declarations ignores the realities and facts established in these declarations.

As Mr. Stout pointed out in his declarations, his invention solved a problem in business, industry and government. The dangers and issues surrounding the Y2K problem should be well-known. It is equally well-known that the only legitimate implementation to prove the inventive concept and permit refinement of the invention is through a business, organization or governmental agency. Mr. Stout is not a business or government entity and therefore did not possess the business and computer infrastructure that would be affected by the Y2K problem and that could be used to establish that his invention solved the problem. Consequently, Mr. Stout did the only thing that a retired veteran could do – he sought to enlist the assistance of business, industry and government to actually reduce his conception to practice.

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Contrary to the Examiner's assertion, all of Mr. Stout's efforts were all directed toward achieving an actual reduction to practice of his invention. Like most individuals, Mr. Stout lacked the business infrastructure essential to demonstrate that his invention was workable, or necessary to help him refine the invention. Mr. Stout's activities are no different than the efforts of the inventor in Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 38 U.S.P.Q. 1288 (Fed. Cir. 1996). In this case, the Federal Circuit found diligence where a substantial part of the inventor's efforts were directed toward finding companies capable of manufacturing his invention.

The final ground for rejecting the three declarations of Mr. Stout was that the claim of diligence was not complete. In ignoring Mr. Stout's declarations and the facts that they establish, the Examiner has established an impossible, and legally improper, standard for proving diligence. The law only requires that the inventor demonstrate "reasonable diligence". See, Mahurkar. In judging diligence, it is necessary to "consider the reasonable everyday problems and limitations encountered by an inventor". Griffith v. Kanamaru, 816 F.2d 624, 2 U.S.P.Q. 2d 1361 (Fed. Cir. 1987). "To satisfy the 'reasonable diligence' requirement, however, it is not necessary to show that an inventor moved from conception to reduction to practice in the shortest time possible, or as quickly as another inventor did. The 'reasonable diligence' standard requires the trier of fact to consider all pertinent circumstances – in light of the policy that drives this norm". RasterOps v. Radius, Inc., 861 F. Supp. 1479, 1494 (N.D. Cal. 1994); see also, Smith v. Crivello, 215 U.S.P.Q. 446 (Bd. Pat. Interf. 1982) (if an inventor is diligent before and after an excused period, it is presumed that but for the excuse the inventor would have been diligent during that period).

The inventor, Wesley Stout, has worked continuously on this invention since its conception. He has worked to develop his invention to the greatest extent possible, though hampered at times due to medical problems on the part of both he and his wife. The declaration and supporting documents establish that Mr. Stout was constantly working to reduce his invention to practice in the only way that he knew how, and in the only way available to a retiree with limited resources and no facilities to test his invention on his own. Mr. Stout could do nothing else but try to get some assistance from a company, organization or governmental agency. Mr. Stout did everything that an inventor in his circumstances could do.

The failure to fully consider Mr. Stout's declarations and cavalier dismissal of Mr. Stout's continuous efforts is not in accord with the law. A big company with extensive resources and infrastructure might have been able to reduce this invention to practice in a shorter period of time, but the big company is not the standard by which reasonable diligence under the circumstances is to be judged. Mr. Stout's diligent efforts, even in the face of significant adversity, should not go unrewarded simply because an un-attainable standard for diligence has been applied.

The three declarations of Mr. Stout should be reconsidered. They establish conception and reasonable diligence to a constructive reduction to practice, and are sufficient to swear behind the Adamchick reference. Since the Adamchick patent does not claim the same or similar subject matter it is clear that no un-articulated policy is being served by denying a patent to Mr. Stout on his novel contribution to the Y2K dilemma.

Having established reasonable diligence in the reduction to practice during the critical period, claims 1-4 are believed to be immediately allowable. Reconsideration of the present application in view of the several § 1.131 Declarations and the foregoing remarks is requested. Action toward a Notice of Allowance is solicited.

Respectfully submitted,



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